

BEST AVAILABLE COPY

PATENT
Our File: WILL 2501

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:
BILL L. DAVIS and JESSE S. WILLIAMSON

For Reissue of U. S. Patent 5,630,363
Issued May 20, 1997
Serial No. 08/515,097

For: **COMBINED LITHOGRAPHIC/
FLEXOGRAPHIC PRINTING
APPARATUS AND PROCESS**

Filing Date: May 20, 1999
Examiner: S. Funk
J. Hiltun

Serial No.: 09/315,796

**JOINT DECLARATION (1) UNDER 37 C.F.R. §1.131
and (2) PERTAINING TO DERIVATION BY DeMOORE AND
PRINTING RESEARCH, INC. OF REISSUE APPLICANTS' INVENTION**

TO: The Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

SIR:

The undersigned reissue applicants, (1) Bill L. Davis, residing at 1126 Tipton Road, Irving, Texas 75060; and (2) Jesse S. Williamson, residing at 5728 Caruth, Dallas, Texas 75298, and both being United States citizens, declare that:

1. We are the same joint declarants of a REISSUE DECLARATION executed on or about May 20, 1999, and of a SUPPLEMENTAL REISSUE DECLARATION executed March 9, 2000, and wish again to reaffirm our affirmation that we believe ourselves to be the original, first and joint inventors of the invention described and claimed, and of the invention and discovery described, in United States Patent No. 4,630,363, for which we seek reissue. We also executed a Joint Declaration Under 37 C.F.R. §1.57(b) on May 20, 1999 ("the Rule 57 declaration").

2. We have reviewed the Office Action dated February 8, 2000, mailed February 9, 2000 and note the Examiner's rejection of Claims 1-6, 9-20, 22-25 and 28-38 (Office Action at page 7) allegedly as anticipated under 35 U.S.C. §102(e) in view of DeMoore et al., U.S. Patent No. 5,960,713 and of Claims 7-8, 21, 26, 27 and 39-87 (Office Action page 8) under 35 U.S.C. §103(a) as allegedly obvious over the same DeMoore et al. We filed an Amendment under 37 C.F.R. §1.111 on April 7, 2000 and wish again to note our beliefs as we stated in said Amendment that DeMoore et al.'s '713 patent is one of three issued U.S. patents all based on a common specification filed October 2, 1995 and that DeMoore's specification Serial No. 08/435,798 is radically different, having different description of the invention and different

T02290 "9645TE60

BEST AVAILABLE COPY

TOP SECRET - DEFENSE

figures than the '713 patent, so that DeMoore et al. cannot be entitled to the May 4, 1995 filing date of Serial No. 08/435,798. We believe any fair examination of Serial No. 08/435,798 by one of ordinary skill in the art will lead said artisan to the conclusion that Serial No. 08/435,798 does not describe nor provide an enabling teaching of any of the claims of the '713 patent and therefore cannot place the artisan in possession of the '713 claimed invention. The '713 patent is a semi-permanent conversion of an offset lithographic printing press for flexographic production. This non-retractable unit applies coating to a flexographic plate mounted on either the plate or blanket cylinder of an offset lithographic printing press for direct or indirect (offset) flexography. The '713 patent does not use a cantilevered device as shown in Serial 08/435,798 or any other retractable mechanism and, in fact, teaches away from Serial 08/435,798. We also wish to note REISSUE APPLICANTS' MEMORANDUM CONCERNING THE PRIOR ART AND THEIR POSITION ON PATENTABILITY (the "MEMORANDUM") and the attached declarations thereto of Baker, Bird (two declarations), Brown and Garner.

3. As corroborated by the Declaration (attached to the MEMORANDUM) of former PRI salesman Steve Baker, executed November 3, 1999 and paragraphs 5-8 thereof, we met with Steve Baker at an Atlanta restaurant (Morton's Steakhouse) in the late evening on a Sunday in late July, 1994 and disclosed to him the broad aspects of our invention to-wit, that Williamson Printing Corporation's ("WPC's") proprietary "WIMS" process (now U.S. pat. 5,370,976) could be improved by employing flexography at a printing station we designated as "upstream" of one or more printing stations of an offset lithographic press that we would receive from Heidelberger Druckmaschinen A.G. ("Heidelberger").

4. In fact, we had first conceived of this process upon the return of Jesse Williamson to the United States from Germany in late May, 1992. The conception was inspired -- at least in part -- by Jesse Williamson's observation of printing with an anilox roller at the coating tower at the plant of M.A.N. - Roland in Offenbach, Germany in late May 1992. In later '92 or early '93, WPC undertook a lengthy study to determine what presses WPC would purchase to replace its existing outdated presses. Until this study was completed and new presses were installed, it was not practical to reduce to practice our '363 process. As of the time of the restaurant meeting with Baker, we had then just returned from Germany and had already reached an oral agreement that WPC would purchase a number of offset lithographic presses from Heidelberger's United States subsidiary, Heidelberg U.S.A. ("Heidelberg").

5. As of the time of the July 1994 meeting, WPC reissue applicants' assignee had settled a lawsuit with Steve Baker's then employer, Printing Research Corporation ("PRI"). Part of the settlement involved an obligation on the part of WPC to buy an agreed dollar amount of equipment and/or supplies from PRI. WPC had committed in early August 1994 to purchase dryer equipment from PRI for a line of Heidelberger printing presses to be installed at WPC starting in late 1994 running well into 1995. In fact, as part of the Atlanta trip, of the undersigned, Jesse Williamson was shown by Steve Baker a PRI-constructed HV interstation

TOPLESS "9625TE60

drier at a local carton printer manufacturer in the Atlanta area. The undersigned reissue applicants also disclosed to Steve Baker WPC's proprietary "WIMS" process - later to become U.S. Pat. 5,370,976 - concerning the printing of metallic inks. We informed Steve Baker that a patent application was pending concerning the "WIMS" process. We showed Steve Baker some Rolex watch advertisements that were part of some jewelry catalogues that were printed by the WIMS '976 process. Jesse Williamson picked up the bill for dinner, even though Steve Baker was the salesman trying to sell WPC equipment.

6. We told Steve Baker at the Atlanta restaurant that we had conceived an invention to improve the WIMS process to make the metallic inks printed appear even more brilliant. As stated above, we told Steve Baker that we wanted to use flexography at a printing station we designated "upstream" - perhaps even the first station --- of one or more printing stations of an offset lithographic press that WPC would receive from Heidelberg. We mentioned several ways in which this could be done --- by a dedicated flexographic station which would replace an existing lithographic station, by a bolt-on manually added (like a "T-head", modified) device that would be used on a run-by-run basis, or a retractable or "rack-back" mechanism sold in the trade, which would have to be modified for "upstream" use. We mentioned that with respect to the rack-back option, that we would have like a retractable mechanism with an anilox roller and a chambered doctor. We would employ state-of-the-art flexographic plates. We mentioned that we had seen the use of some of these flexographic plates in Germany in late May 1992 and again in July 1994 and that a number of companies sold high-resolution plates which would work in our new process. We asked Steve Baker whether or not PRI was interested in supplying these types of rack-back or retractable devices. Steve Baker told us that PRI had available for modification an end-of-press rack-back, not dissimilar to (a) Dahlgren International's end-of-press device currently sold and (b) other devices which were sold by PRI's competitors. We were told PRI's rack-back was developed by PRI employee, John Bird, when John Bird was employed previously at another company in the eastern part of the United States. We had seen rack-back literature as of 1994 from a number of companies, including Dahlgren, Oxy-Dry, IBC, Rapidac, INT, Epic, and PRI. Dahlgren had sold rack-backs for many years with anilox rollers, and on request, supplied a chambered doctor to units ordered. Any one of a number of rack-back vendors could have easily altered their end-of-press rack backs to make same an interstation device as of 1994.

7. We indicated to Steve Baker that we wanted to run some tests at Printing Research using the retractable equipment which might be modified for interstation use. These tests - conducted for WPC occurred later in 1994, specifically in October and December, as we recall. The tests concerned spot coating of selected images, including the application of metallics (our specialty in view of WIMS '976), opaque colors and encapsulated essences, as well as the evaluation of the resolution of flexographic plates. From approximately August to early October 1994, we investigated several flexographic plate manufacturers (DuPont, BASF and W.R. Grace

BEST AVAILABLE COPY

FOIA250 "916245TE60

(Polyfibron) that supplied WPC with the flexographic plate technology used in the October and December 1994 tests at PRI. The plates were made at Chicago Lithoplate and Wilson Engraving using raw plate materials supplied by the manufacturers and negatives supplied by WPC. For these tests at PRI, we supplied the substrates, the flexographic plates, the subject matter for the plates (selected films from previous jobs), and the flexographic inks and coatings. The tests were conducted at PRI at Bill Davis' direction. The December 1994 tests continued the October tests, and were also under Bill Davis' direction. We had much earlier, in our July 1994 trip to Germany, begun our investigation of the manufacture of flexographic printing plates, which included, in due course, discussions with the foregoing plate manufacturers.

8. In a series of meetings and conferences, which started on or about August 18, 1994, we conveyed to John Bird details of the '363 process we wanted implemented by a modified "rack-back" device to go "upstream", together with these tests we wanted run in the fall of 1994 using the 2-color press at PRI. Specifically, among other things, we disclosed to Bird (a) the resolution requirements for flexographic plates for our process, (b) requirements for anilox rollers, including line screening count ranges and minimums, and the availability of anilox rollers having desired features, (c) the WIMS '976 process (now U.S. Patent 5,370,976), (d) the problems with the printing of metallic/whites/opaque/encapsulated essences/and various other coatings with WIMS '976, (e) our desire that the flexographic plates be mounted to the blanket cylinder, (f) our uses of and requirements for flexographic inks and coatings, (g) half-tone printing, and (h) drying requirements for the new process. These matters were discussed in various meetings with Bird starting in August 1994 and proceeding through very late 1994 into early 1995. We notice in a review of the application filed as Serial No. 08/435,798 and its European equivalent EP 741,025 (A2) that the process aspects of this application filed in the name of three PRI employees, including Bird, discloses process features we told Baker and Bird from July 1994 through the end of 1994. We do not believe that any of the important process aspects taught in the PRI application pertaining to the '363 claimed invention originated with anyone other than the undersigned, through Bird and Baker. PRI derived the process aspects of their May 4, 1995 priority patent application from us.

9. As stated, Bill Davis conducted and supervised the fall 1994 tests at PRI using flexographic plates, inks and coatings supplied by WPC. WPC did not enter into a formal written understanding committing PRI to build for us any rack-back devices of any type prior to February 1995, after we returned from Germany in January 1995, where we successfully simulated the '363 process, although we told PRI and Baker (and later Bird) from July 1994 forward that PRI would be in the running for the business if PRI made such an interstation device.

10. We were never told at any time prior to early 1995 by anyone at PRI that anyone at PRI thought some PRI employee had conceived the '363 process. We clearly came up with the process, as is corroborated by the Baker and Bird declarations. We even informed WPC's

EST AVAILABLE COPY

Chairman, Jerry Williamson, of some of the prospective advantages of the process. Note the internal memorandum of November 18, 1994, paragraph no. 6 on page one, the first document of group **Exhibit A**, and a later memorandum dated December 16, 1994, item two.

11. Starting in the late summer of 1994, we had a parallel track we were pursuing concerning the development of our invention as we did not know whether PRI would perform, wanted to perform, or would be price competitive with a modified rack-back. We had disclosed the invention to Heidelberg U.S.A.'s salesman Scott Brown no later than August 5, 1994 – flexography being performed first followed by offset lithography, all in one pass. We explained, as we had done to Steve Baker, the various options of having this done, e.g., a dedicated station, a mounted unit, or an auxiliary retractable unit. We explained to Scott Brown that we wanted a simulation of the invention (flexography printed first followed by lithography in a second pass), and Heidelberger originally scheduled the simulations the week of December 10, 1994. See **Exhibits B** and **C**. Because of the holidays, this simulation was rescheduled for January 20-21, 1995. The tests were carefully planned. (**Exhibit J**). BASF supplied the flexographic plate making equipment for our tests in Germany, even sent WPC a proposal in the first part of October, 1994. (**Exhibit D**)

12. On January 20-21, 1995 the first simulated reductions took place in Germany. The day-long tests on January 20, 1995 involved comparisons of the results of the new WIMS improved process (or "WIMS II") over the old process and involved rerunning some established WPC advertisements made for Rolex, some art work involving a 1957 Chevrolet bumper grill, an apple of some configuration, a memorable portion of an automobile brochure comprising a silver Lexus driving on a wet cobblestone road (having a shimmery look with a gold reflection off of puddles on the cobblestone), and finally some test-type patterns, to be run through the press, first with one or more flexography runs using an anilox roller and the BASF flexographic plates obtained for us at our request from Scott Brown of Heidelberg U.S.A., and followed up by offset lithography. With respect to the Lexus brochure portion, the multiple hues of the gold and silver metallic, blended with the natural wet cobblestones, were most impressive. The tests took all day from early in the morning until well after dark, and continued the next day. We directed the work of the German Heidelberger Druckmaschinen A.G. technicians. There was unusual brilliance for the metallic inks involved, and without distortion. Several hundred impressions were printed, and sent through the presses in multiple passes, with the flexography step being done first, as the anilox roller existed end-of-press on the coating tower. The second day, January 21, 1995, involved more tests. The results – especially comparing the older results of the WIMS process with the new, improved process were very, very impressive – the enhanced brilliance of the metallic colors in the Rolex advertisement and the Lexus brochure were especially memorable, as the impressions had a sheen that was clearly of more brilliance than the older WIMS counterpart impressions. Note a copy of one of the first Rolex advertisement sheets produced by a simulation of the invention, **Exhibit E**. No one attended the tests from PRI, but

FD250 "91625TE60

we told PRI executive Garner of the results that day since he was also in Heidelberg on business and we happened to see him at his hotel.

13. Also, in January 1995, a meeting took place in Conference Room E at WPC, which was attended by the undersigned reissue applicants, as well as John Bird and Steve Baker of PRI. At this meeting, Jesse Williamson told Bird and Steve Baker that he (Williamson) and Davis were going to file a patent application on their new process.

14. By early February, we decided to go with the modified PRI rack-back, rather than having a dedicated flexography station manufactured by Heidelberger. PRI wanted to install an experimental "short-arm," end-of-press prototype device on the first Heidelberg press to arrive at WPC for what they described as for their own purposes. This experimental "short arm", cantilevered device was provided to WPC at no charge and was installed on the tower coater of the new Heidelberg 7-color press in late February, 1995. By March 4 or so, we had Heidelberg executives and the foreign press in Dallas, some of whom saw the first U.S.A. simulation of the invention on March 4, 1995. There was even a publication of this "WIMS II" ('363) simulation - see group **Exhibit F**. Later on March 20, 1995, we ran the first commercial job using a simulation of the '363 invention for a Washington D.C. client - Mills Davis and Hi-Fi Color (the so-called "Brian Lester" poster), for which WPC won an award at the PIA's Premier Print Awards in late 1995 in Chicago, Illinois. Later off-line simulations occurred in May 1995 for Wolstenholme - a brochure ("Take a Ride With WIMS") for 1995 DRUPA - and the Dallas Opera in July 1995 ("Madame Butterfly").

15. Although we had orally committed by early February 1995 to purchase from PRI modified rack-back devices (See **Exhibit H**) to carry out the '363 process, PRI's confirmatory letter for a time table for installation of the first interstation device was not transmitted to WPC until May 12, 1995, setting 90 days for completion. (See **Exhibit G**). This first "long-arm", or automated unit, was actually installed in late August 1995 or early September 1995, and to the best of our knowledge the first actual in-line reduction of the invention occurred at WPC in mid-September, 1995.

16. As indicated, we told PRI representatives in January, 1995 that we were going to file a patent application on our process. From early May 1995 until the filing date of our application in mid-August, 1995, we recall we were involved in the drafting and redrafting of a patent application with our attorney Al Hall, the drafts of which we assert our attorney-client privilege. See '363 privilege list for May 4, 1995 - August 14, 1995, **Exhibit I**. According to this privilege list, there were at least three drafts of the patent application, consistent with what we recall. Pertaining to the '363 invention, the time period from May 3, 1995 to our filing date in August 1995 was consumed by said patent drafting activity, simulations of the process, and anticipated installation of the first '363 interstation device.

17. Paragraph 3 of our Rule 57 declaration executed May 20 1999, states, in part, that "[i]n approximately December 1994, Petitioners requested Printing Research to design and install on the tower coater at the

BEST AVAILABLE COPY

end of Williamson Printing's seven-color press an experimental flexographic printer coater having an anilox roller."

For several reasons, as explained below, this statement is in error. First, we now know they we never requested the construction of an experimental unit. Second, following the disclosure of the '363 process to Steve Baker in the summer of 1994, we expressed our desire to Steve Baker, John Bird and others at PRI to obtain a retractable printer/coater with an anilox roller and a chambered doctor for upstream use with the '363 process. Baker and Bird indicated that PRI could produce such a device. Accordingly, process design details were disclosed to Bird and others throughout the fall of 1994 and into 1995. Third, PRI constructed an experimental flexographic printer/coater, which was installed at the tower coater at the end of WPC's seven-color press at the end of February 1995, but this experimental unit was not requested by WPC.

18. The errors in the Rule 57 declaration statement quoted above in paragraph 17 were made inadvertently and without deceptive intent. The reasons for the errors in the above statement are that the Rule 57 declaration was prepared as part of the reissue papers in a short time period of four days prior to and including May 20, 1999; we did not have the opportunity to review all of the relevant 1994 and 1995 documents from WPC's and our files relating to this matter before execution of the declaration, and John Bird's letter of February 16, 1995 (Exhibit G), which was reviewed by us and was the first correspondence from PRI relating to construction of the interstation flexographic printer/coater by PRI, contained several errors, which we believe were unintentional and inadvertent.

19. Paragraph 5 of our Rule 57 Declaration also states in part, that

"[i]n approximately January or early February 1995, Petitioners requested Printing Research, Inc. to design and to install on the first printing station of the triple tower press a flexographic printer/coater like the experimental coater installed on the seven-color press. This unit was installed on the seven-color press in approximately mid-March 1995. Thus, at or about this time, Petitioners' invention was disclosed or imparted, at least in part, to Printing Research, Inc.."

For several reasons, as explained below, this statement is also in error. First, we now know that we never requested the construction of an experimental unit. Second, following the disclosure of the '363 process to Steve Baker in the summer of 1994, we expressed our desire to Steve Baker, John Bird and others at PRI to obtain a retractable printer/coater with an anilox roller and a chambered doctor for upstream use with the '363 process. Baker and Bird indicated that PRI could produce such a device. Accordingly, process design details were disclosed to Bird and others throughout the fall of 1994 and into 1995. Third, PRI constructed an experimental flexographic printer/coater, which was installed at the tower coater at the end of WPC's seven-color press at the end of February 1995, but this experimental unit was not requested by WPC. Fourth, on or about February 11, 1995, a meeting was held at WPC in which PRI confirmed that it would construct and install such a retractable interstation device on the first printing station

F02250 "91625TE60

of WPC's newly arrived six-color press. This first interstation device was the subject of a second confirmatory letter, dated May 12, 1995, from Bird to Jerry Williamson, which gave ninety (90) days for completion. The interstation device was actually installed on the first station of WPC's six-color press in late August or early September 1995, as noted in paragraph 15 above. Fifth, we first informed Steve Baker and PRI of our invention, as indicated above in paragraphs 5-6, in July 1994, and the details of the invention to Bird of PRI, as noted in paragraphs 8-9, in the fall of 1994.

20. The errors in the Rule 57 declaration statement quoted above in paragraph 19 were made inadvertently and without deceptive intent. The reasons for the errors in the above statement are that the Rule 57 declaration was prepared as part of the reissue papers in a short time period of four days prior to and including May 20, 1999, we did not have the opportunity to review all of the relevant 1994 and 1995 documents from our files relating to this matter before execution of the declaration and John Bird's letter of February 16, 1995, which was reviewed by us and was the first correspondence from PRI relating to construction of the interstation flexographic printer/coater by PRI, contained several errors, which we believe were unintentional and inadvertent.

21. In addition to the aforesaid errors, a number of errors pertaining to dates exist in the Rule 57 declaration. In paragraph 1, there is an indication that "in approximately June 1994", WPC ordered several presses from Heidelberg Druckmaschinen A.G. True, an oral commitment was made in June between WPC and Heidelberger, but written confirmation did not occur until August, 1994. This error was made inadvertently, and without deceptive intent. We did not have the opportunity to review our corporate employer's files or our personal files when we executed the Rule 57 declaration on May 20, 1999. A similar date error as to the purchase of new press equipment occurred in the first sentence of paragraph 4, likewise made inadvertently and without deceptive intent.

22. Still other date errors occurred in paragraph 1 of the Rule 57 declaration:

"One of these presses, a seven-color press with a tower coater (the seven-color press") was installed at Williamson Printing in approximately October 1994 ... In approximately October-November 1994, Printing Research demonstrated to Petitioner's its end-of-press anilox coating system, known as the plate blanket coater."

The installation of the press identified was started in September 1994, not October 1994. Additionally, tests at PRI were conducted in October 1994 and December 1994, but under WPC's direction and control, as noted above in paragraph 9. Such errors in our Rule 57 declaration were made inadvertently and without deceptive intent.

23. Likewise, another date error occurred at the end of paragraph 3 of the Rule 57 declaration:

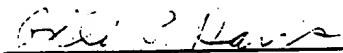
FOIA2007-0154-CASE60

"The only correspondence we can find between Williamson Printing Corporation and Printing Research, Inc. after Exhibit 1, and prior to installation of the interstation printer/coater, is attached hereto as Exhibit 2."

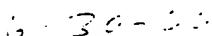
After a chance to review WPC's and our own records, we found Bird's proposal of May 12, 1995, **Exhibit G**, and an assortment of documents pertaining to negotiations between the parties, **Group Exhibit K**. This is strictly an error in dates, as we previously declared that the first interstation unit was delivered in mid-March, 1995 (see Rule 57 declaration, paragraph 5 discussed above), when the first interstation unit was actually delivered in late August 1995 or early September 1995. See paragraph 15 above.

Other than the errors noted above, the remainder of the comments in the Rule 57 declaration not inconsistent with the statements made in this declaration after a review of our documents, we reaffirm as we still believe they are true and correct.

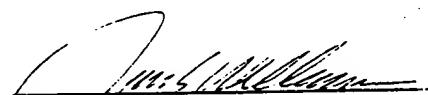
The undersigned Declarants state that all statements made herein of Declarants' own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.



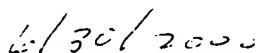
Bill L. Davis



Date



Jesse S. Williamson



Date

TEST AVAILABLE COPY